PATENT
Cope et al.

Attorney Docket No. CIT1510-4

Application No.: 10/047,253

Filed: January 14, 2002

Page 7

II. REMARKS

Claims 1-71 are pending. Claim 32 is amended herein, and claims 72-76 are newly added. Claims 1-31 and 58-71 are canceled herein without prejudice. Applicants elect, with traverse, the claims of Group VI, claims 32-57. Furthermore, Applicants elect, with traverse, Rpn11 as the polypeptide including the JAM domain, isopeptidase activity as the JAM domain activity, a ubiquitin modifier protein, and a Sic1 protein target. Upon entry of the amendment, claims 32-57 and 72-76 will be pending. Applicants respectfully request examination of newly added claims 72-76 along with the elected claims of Group VI because these claims read on the elected groups.

No new matter is added with the claim amendments or new claims. The Amendment to claim 32 clarifies the claim, and is supported by claim 32 as filed. Furthermore, the Amendment to claim 32 is supported, for Example, by paragraph [0048]. Newly added claims 72 and 73 are supported, for example, by paragraphs [0030] and [0069]. Newly added claim 74 is supported, for example, by paragraph [0050]. Newly added claims 75 and 76 are supported by, for example, by paragraph [0028].

The Commissioner may require restriction if two or more independent or distinct inventions are claimed in one application (MPEP § 802.02; 37 CFR § 121), and if there is a serious burden on the examiner (MPEP § 803). Applicants traverse the election requirement for an activity for the JAM domain, in part because claim 32 does not recite an activity. Furthermore, the activity is inherent in the elected polypeptide including a JAM domain. Therefore, a search of Rpn11, for example, will be no more burdensome based on the activity elected.

Regarding the election of a target, Applicants respectfully assert that it will not be a serious burden on the Examiner to search different targets. Applicants assert that a search of the method of the invention related to a method for screening an agent that affects deconjugation of a modifier protein that is conjugated to a target protein via a peptide bond between the carboxy terminus of the modifier protein and a free amino group of the target can be searched without undue burden on the examiner, without further restriction of a particular target. This is especially true when considering that the search will apparently be restricted to

• In the Application of: Cope et al.

Application No.: 10/047,253

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Page 8

PATENT

Attorney Docket No. CIT1510-4

a method that includes incubation with a polypeptide that includes Rpn11. Accordingly, Applicants respectfully request that all targets be examined together in the present application.

In view of the amendments and the above remarks, it is submitted that the claims are in condition for allowance and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application. A Petition for Extension of Time of One Month, and the required fee check are enclosed herewith. Please charge any additional fees, or make any credits, to Deposit Account No. 50-1355.

Respectfully submitted,

Date: August 22, 2003

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